

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejections under 35 USC § 103

- 1) The rejection of claims 1-3, 7 and 8 under 35 USC § 103a as being unpatentable over the acknowledged prior art in view of Kayser et al. (USP 6,295,212), is respectfully traversed.

In this rejection, it is acknowledged that the “acknowledged prior art” does not disclose a first filter capacitor having a capacitor terminal connected electrically to a third node, and a second capacitor terminal connected electrically to the ground. It is additionally admitted that the “acknowledged prior art” does not disclose a voltage regulator interconnecting the second and third nodes, and further does not disclose a regulator terminal connected electrically to ground so that a regulated direct current voltage is provided to a direct current brushless fan motor through the third and ground nodes.

To overcome this admitted shortcoming, the rejection turns to Kayser et al. which is indicated as teaching the use of a capacitor C2 which is connected across output terminals along with a Zener diode D3 which is connected in parallel with the capacitor C2. This arrangement is alleged to regulate output voltage. The rejection goes on to indicate that Figure 2 of Kayser clearly shows the voltage regulator Zener diode D1 connected in parallel with the filter capacitor C3. For this reason alone, the rejection then alleges that it would have been obvious to one of ordinary skill in the art to employ the Zener diode in parallel with a capacitor in the manner disclosed in Kayser et al., thus derive the claimed subject matter.

It is respectfully submitted that this rationale fails to establish a *prima facie* case of obviousness. Most specifically, a review of the Kayser et al. reference indicates that the capacitor C2 and Zener diode D3 are connected in parallel across an AC source – viz., the output of a transformer. This must be contrasted to the claimed subject matter, wherein the

capacitor and Zener diode are connected across a rectified AC source and therefore are connected across a source of DC current.

This notwithstanding, there is nothing advanced in this office action which would establish the necessary motivation for the allegedly obvious combination. The only position taken is that "it is known" so "it's obvious."

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In a nutshell, the arrangement of Kayser et al. is connected to a source of alternating current. On the contrary, the claimed arrangement is connected to the output of a rectifier, and therefore connected with a source of DC current. This represents a major stumbling block toward the realization of the claimed subject matter in that there is no reason for the hypothetical person of ordinary skill to look to a circuit arrangement which is intended to respond to AC current for application to a circuit which is supplied with DC current from a rectifier.

That is to say, the claimed subject matter is directed to a parallel converter module for direct current brushless fan motors and the like type of loads, and includes a metal thin film capacitor and a voltage regulating unit. The metal thin film capacitor protects a limiting

resistor of the voltage regulating circuit from burning out. A voltage regulator of the voltage regulating circuit protects the fan motor from voltage fluctuation. By combining the voltage regulation circuit with the metal film capacitor, the service life of the fan motor can be prolonged.

Were the hypothetical person of ordinary skill to consider a combination of the acknowledged prior art with Kayser et al., the best that could be expected would be the unlikely choice of interposing the capacitor and Zener diode in parallel across the terminals of the source of alternating current; therefore, between the source of alternating current and the rectifier of the acknowledged prior art. Clearly, there would be no suggestion of introducing such structure between the output of the rectifier and a load such as a fan motor. Indeed, as noted above, there would in fact appear to be teachings to the contrary wherein the only possible introduction of the Zener diode and capacitor would be between the AC source and the rectifier.

A reference must be considered for all it teaches, including disclosures that teach away from the invention as well as disclosures that point toward the invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. 776 F.2d 281, 227 U.S.P.Q. 657 (Fed. Cir. 1985).

A further hinderance to the proposed combination resides in that the Kayser et al. arrangement is directed to a power supply for microprocessor applications as distinct from brushless fan motor applications. As a result it boards on non-analogous art.

It is respectfully submitted that the Examiner has failed to meet his burden of presenting the necessary motivation which would lead the hypothetical person of ordinary skill in the art towards a combination of the teachings of the acknowledged prior art and the teachings which can be gleamed from the Kayser et al. patent. Indeed, the fact that the rejection overlooks the connection of the capacitor C2 and Zener diode or Kayser et al. to a source of alternating current as different from a source of DC current, is seen as presenting reason which, without resolution, would prevent the establishment of a *prima facie* case of obviousness.

- 2) The rejection of claim 4 under 35 USC § 103a as being unpatentable over the acknowledged prior art in view of Kayser et al. and further in view of Lawson (USP 5,637,789), is respectfully traversed.

This rejection fails to establish a *prima facie* case of obviousness for at least the reasons advanced above. Further, it should be appreciated that the Lawson reference is directed to a circuit arrangement for supplying DC power to a leak sensing circuit. This has no relevance to a circuit which is directed to supplying current (direct current) to a brushless fan motor. Indeed, it is not seen that there is anything in either Kayser et al. or Lawson that would motivate the hypothetical person of ordinary skill in the art to conclude that any teachings could be transferred to the acknowledged prior art with any benefit being derived.

As made clear in MPEP 2143.01 the prior art must suggest the desirability of the claimed invention. That is to say, "there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Further, in this rejection it is again submitted a mere statement of disclosed structure is insufficient to motivate toward combination. Indeed, all that is advanced is that certain structures are, in fact, disclosed. This is then followed by an unsupported conclusion that it would be obvious to transfer teachings to the Kayser et al. arrangement or the acknowledged prior art. This, of course, is untenable and fails to met the requirements under 35 U.S.C. § 103a for the establishment of a *prima facie* case of obviousness.

Carella V. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."

- 3) The rejection of claim 5 under 35 USC § 103a as being unpatentable over the acknowledged prior art in view of Kayser et al. and further in view of Munshi (USP 6,426,863), is respectfully traversed.

In this rejection, the Munshi reference is applied to disclose a metal thin film capacitor which is made from Zinc. The teachings of this reference fail to overcome the inherent problems which are encountered with the basis combination of the acknowledged prior art and the Kayser et al. reference. Therefore, in this instance also, the rejection fails to establish a *prima facie* case of obviousness.

In *ACS Hospital Sys., Inc. v. Montefiore Hospital*, the Federal Circuit asserted that "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir.1984).

- 4) The rejection of claim 6 under 35 USC § 103a as being unpatentable over the acknowledged prior art in view of Kayser et al. and further in view of Farrall et al. (USP 5,047,893), is respectfully traversed.

In this rejection, the Farrall et al. reference is relied upon to teach the use of silver plated copper for making capacitors. For the same reason advanced above, this rejection fails to establish a *prima facie* case of obviousness. That is to say, this rejection is based solely the position that A is known so that it would be obvious to introduce A into arrangement B. No motivation is advanced and no reasons why the hypothetical person of ordinary skill in the art would be motivated to even to contemplate the use of the teachings of Farrall et al. in the basic combination of the acknowledged prior art and Kayser et al., is advanced.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992). M.P.E.P. § 2143.01.

Conclusion

The claims as they stand before the PTO are patentable over the art which is applied for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited

Respectfully submitted,

Date 24 August 2005

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